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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/238,502	01/27/1999	YOSHIKAZU KOBAYASHI	Q52863	6211

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2100 PENNSYLVANIA AVENUE NW
WASHINGTON, DC 20037

EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
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2646

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/238,502

Applicant(s)

KOBAYASHI, YOSHIKAZU

Examiner

Walter F. Briney III

Art Unit

2646

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10, 12, 14, 22, 23, 27, 28, 32-37, 46 and 47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12, 14, 22, 23, 27, 28, 32-37, 46 and 47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05 October 2005 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-10, 12, 14, 22, 23, 27, 28, 32-37, 46 and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over the PrimaSoft Dialer version 1.4 (Copyright 1995, 96 by PrimaSoft PC, Inc.).**

Claim 1 is limited to *a telephone call dialing method, for use in an information terminal with an operating system which can display a plurality of windows*. PrimaSoft developed a program named Dialer—copyright 1995, 96—for use with Windows 3.1/95, a GUI layered on top of the MS-DOS operating system. Windows 3.1/95 enabled multiple windows of information to be stacked and arranged on a single

monitor, enabling multiple simultaneous data views. The PrimaSoft Dialer enables a user to enter a telephone string into a "Number to Dial" box and by actuating a Dial button, automatically dial said telephone string. The PrimaSoft Dialer function window is shown in figure 2. Figure 5 depicts a dialing function, figure 6 depicts a call completion function, and figure 7 depicts a call connection function. While the core features of the Dialer are clear from figures 2 and 5-8, there is no indication as to how telephone numbers are entered. Therefore, the PrimaSoft Dialer anticipates all limitations of the claim with the exception wherein *a string of character information in a window displayed by the operating system is selected, stored, extracted and subsequently dialed.*

The examiner takes Official Notice of the fact that it was well known at the time of the invention to copy-and-paste information from one window displayed by the Windows 3.1/95 GUI (OS) to another window. The notoriously well-known copy-and-paste feature was known to simplify data entry on information terminals by reducing the number of repetitive keystrokes necessary to transfer character strings between applications. In a conventional non-windows environment, text strings are copied manually, such as remembering the string and entering each character of said string one character at a time with the keyboard. The copy-and-paste eliminates the overhead of remembering the string, by allowing text (i.e. *string of character information*) to be *selected* from one *window* as seen in figure 3 and *stored* in the *OS memory* by the copy action. The *selection* and *storing* functions described above correspond to collecting data from a first window, or a *first operation* as claimed. Furthermore, the stored string

is pasted into the target window as shown in figure 4, the result shown in figure 5. The dial operation subsequently *extracts* and *dials* the digit information presented in the "Number To Dial" box of figure 5, essentially ignoring any punctuation used for formatting. The pasting, *extraction* and *dialing* described above correspond to initiating dialing using the collected data from the first window, or a *second operation* as claimed.

It would have been obvious to one of ordinary skill in the art at the time of the invention to copy-and-paste a telephone number in a first window to the PrimaSoft Dialer displayed in a second window as was known in the prior art for the purpose of reducing the overhead involved in manually transferring character-by-character a telephone number in the first window to the second window.

As amended, claim 1 now recites a method step to (1) "automatically dial a call to a line." The Dialer program teaches this, however. Specifically, the Dialer engages the Windows telephony application program interface (TAPI) to generate DTMF tones on a telephone line. In this way, a user needs to only enter a telephone number and engage the Dial button to initiate a telephone call without actually having to pick up a receiver. In other words, the Dialer program automates line seizure and dialing.

Amended claim 1 also elaborates on the actions that make up the claimed second operation; namely, "said second operation is one of pressing at least one button of a pointing device and pressing at least one key of a keyboard." According to the screenshots of the Dialer program, the second operation that involved extracting and dialing was performed using a mouse. Specifically, the right mouse button was clicked once and the left mouse button was clicked twice. In this way, a button was pressed

twice, which is in contrast to the claim language. However, the second operation can easily be executed using single presses of a plurality of keyboard keys. Specifically, the paste function can be executed by pressing CTRL+V and actuating the Dial button can be executed by pressing TAB and then either space bar or enter. In this way, each keyboard button—i.e. “at least one button”—is pressed only once.

Amended claim 1 further elaborates on the actions that make up the claimed first operation; namely, “said first operation is a designation of a region of the displayed second window containing the character information.” However, the first operation was already shown to be a designation of a region of a so-called Notepad. Therefore, the Dialer program makes obvious all limitations of the claim.

Claim 2 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. In accordance with the copy-and-paste feature, the selected dialing string is inherently stored in the common working memory shared by the *operating system*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 3 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. In accordance with the copy-and-paste feature, a dialing string is selected using either mouse or keyboard highlighting features, such as click-and-drag or by holding down the shift and arrow keys simultaneously, and the selection is carried out through a regional designation before being copied to memory, or *stored*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 4 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. Inherently, a telephone number does not include symbols such as parenthesis, dashes or white space as seen in figure 5. Therefore, these extraneous formatting characters are essentially deleted from the outgoing dial string; i.e. *extracting includes deleting information except for that relevant to numerals from the selected string of character information, the telephone number is extracted from the resulting remainder*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 27 is limited to *the telephone call dialing method according to claim 1*, as covered by the PrimaSoft Dialer. Clearly, the notepad depicted in figure 3, from which the dialing string is copied, has no relation to the PrimaSoft dialer and contains no abilities but to enter text; i.e. *wherein said window is associated with an application unrelated to call-dialing*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 28 is limited to *the telephone call dialing method according to claim 27*, as covered by the PrimaSoft Dialer. The Notepad application depicted in figure 3, from which the dialing string is copied, is clearly a *word processor*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 5 is limited to *a telephone call dialing method, for use in an information terminal with an operating system which can display a plurality of windows*. For the same reasons as those presented above with respect to claim 1, it would have been

obvious to perform a copy-and-paste operation with the PrimaSoft Dialer to simplify the operation of the Dialer.

With respect to the precise method steps claimed, the Dialer, in a first step, displays the window shown in figure 2. A user performs a copy, or *first operation*, that includes *selecting* a dialing string (i.e. *a string of character information*) from a Notepad document displayed in a *second window*. The user then actuates the copy function as seen in figure 3, resulting in the selected string being *stored* to the shared OS memory. To dial the number copied, the user simply pastes by way of the method depicted in figure 4, the pasting being associated with the general step of *extracting* under the *second operation* as claimed. Clicking on the dial button as seen in figure 5 initiates *dialing a call to a line based upon the extracted telephone number*.

As amended, claim 5 now recites a method step to (1) "automatically dial a call to a line." The Dialer program teaches this, however. Specifically, the Dialer engages the Windows telephony application program interface (TAPI) to generate DTMF tones on a telephone line. In this way, a user needs to only enter a telephone number and engage the Dial button to initiate a telephone call without actually having to pick up a receiver. In other words, the Dialer program automates line seizure and dialing.

Amended claim 5 also elaborates on the actions that make up the claimed second operation; namely, "said second operation is one of pressing at least one button of a pointing device and pressing at least one key of a keyboard." According to the screenshots of the Dialer program, the second operation that involved extracting and dialing was performed using a mouse. Specifically, the right mouse button was clicked

once and the left mouse button was clicked twice. In this way, a button was pressed twice, in contrast to the claim language. However, the second operation can easily be executed using single presses of a plurality of keyboard keys. Specifically, the paste function can be executed by pressing CTRL+V and actuating the Dial button can be executed by pressing TAB and then either space bar or enter. In this way, each keyboard button—i.e. “at least one button”—is pressed only once.

Amended claim 5 further elaborates on the actions that make up the claimed first operation; namely, “said first operation is a designation of a region of the displayed second window containing the character information.” However, the first operation was already shown to be a designation of a region of a so-called Notepad. Therefore, the Dialer program makes obvious all limitations of the claim.

Claim 6 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. As seen in figure 4-8, the operating system displays multiple overlapped windows, the PrimaSoft Dialer being arranged on top when it is the “active” window as is inherent with all Windows 3.1/95 systems. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 7 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. Clearly, the PrimaSoft Dialer window is in the form of a *toolbar*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 8 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. As seen in figure 8, a list of recently dialed numbers is presented to a user of the PrimaSoft Dialer by clicking on a down arrow next to the

"Number To Dial" box. This arrow and the Dial key correspond to *call dialing keys* within a *telephone region*. The user simply clicks the down arrow, *selects* a recently dialed number, depresses the Dial key and the system parses (i.e. *detects*) the number in the "Number To Dial" box and *call-dials* it as shown in figures 5-7. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 9 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. As seen in figure 8, a list of recently dialed numbers is presented to a user of the PrimaSoft Dialer by clicking on a down arrow next to the "Number To Dial" box. This arrow corresponds to a *call log region*. The user simply clicks the down arrow, *selects* a recently dialed number, depresses the Dial key and the system parses (i.e. *detects*) the number in the "Number To Dial" box and *call-dials* it as shown in figures 5-7. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 32 is limited to *the telephone call dialing method according to claim 5*, as covered by the PrimaSoft Dialer. After pasting the number from memory, it is dialed by actuating the Dial button using, for example, the mouse as seen in figure 5; i.e. *wherein said third operation includes pressing a button displayed in the first window*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 33 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. The Dial button is essentially an *extension button* when used to dial an *internal number*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 34 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. The Dial button is essentially a *line wire button* when used to dial an *external number*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 35 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. Clearly, the PrimaSoft Dialer comprises the *first application and first window* as claimed, and is related to *call-dialing*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 36 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. Clearly, the Notepad depicted in figure 3, from which the dialing string is copied, has no relation to the PrimaSoft dialer and contains no abilities but to enter text; i.e. *wherein said window is associated with an application unrelated to call-dialing*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 37 is limited to *the telephone call dialing method according to claim 32*, as covered by the PrimaSoft Dialer. The Notepad application depicted in figure 3, from which the dialing string is copied, is clearly a *word processor*. Therefore, the PrimaSoft dialer makes obvious all limitations of the claim.

Claim 10 is limited to *an information terminal, with an operating system which can display a plurality of windows*. The terminal claimed simply consists of means that are inherently required to fulfill the method steps of claim 1, whose inherent means and

method steps have been shown to be obvious in view of the PrimaSoft Dialer.

Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 12 is limited to *the information terminal according to claim 10*, as covered by the PrimaSoft Dialer. While not explicitly shown, it is known that the PrimaSoft Dialer only serves to interface between the user and the underlying telephony application programming interface (TAPI) that is truly responsible for dialing from the *information terminal* using a modem, the TAPI and modem correspond to *call dialing control means*. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claim 14 is limited to *the information terminal according to claim 10*, as covered by the PrimaSoft Dialer. As shown in the rejection of claim 4, the extraction means, during the extraction step, removes all non-numeral strings before dialing. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claim.

Claims 22 and 23 are limited to *computer-readable recording mediums, storing programs to be executed by computers*. The programs claimed therein recite essentially the same steps as those of method claims 1 and 5, as covered by the PrimaSoft Dialer, respectively. As the Dialer is in fact a program, the PrimaSoft Dialer makes obvious all limitations of the claims.

Claims 46 and 47 recite essentially the same subject matter as claims 36 and 37, as covered by the PrimaSoft Dialer, respectively. Therefore, the PrimaSoft Dialer makes obvious all limitations of the claims.

Response to Arguments

Applicant's arguments with respect to claims 1-10, 12, 14, 22, 23, 27, 28, 32-37, 46 and 47 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F. Briney III whose telephone number is 571-272-7513. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sinh Tran can be reached on 571-272-7564. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



SINH TRAN

Supervisory Patent Examiner

WFB
12/16/05